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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,843	05/01/2001	Noboru Ogino	01269-LH	7322
1933	7590	07/17/2007	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 Fifth Avenue 16TH Floor NEW YORK, NY 10001-7708			THOMPSON, JAMES A	
ART UNIT		PAPER NUMBER		2625
MAIL DATE		DELIVERY MODE		07/17/2007 PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/847,843	OGINO, NOBORU
	<b>Examiner</b>	<b>Art Unit</b>
	James A. Thompson	2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 April 2007.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) \_\_\_\_\_ is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 4-15 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 01 May 2001 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Response to Arguments***

1. Applicant's arguments, see page 9, filed 20 April 2007, with respect to the rejections under 35 USC §112, 2<sup>nd</sup> paragraph have been fully considered and are persuasive. The rejections under 35 USC §112, 2<sup>nd</sup> paragraph listed in items 3-4 of the previous office action, mailed 23 January 2007, have been withdrawn.
2. Applicant's arguments, see pages 10-16, filed 20 April 2007 have been fully considered but they are not persuasive. Applicant's arguments are directed to the present amendments to the claims. Further, additional prior art has been discovered which renders the presently amended claims obvious to one of ordinary skill in the art at the time of the invention. Thus, the prior art rejections set forth below fully address Applicant's present amendments and Applicant's presently amended claims.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 4-5, 7-9, 11-13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hisatake (US Patent 5,669,040) in view of Markham (US Patent 4,273,439) and Yoshiura (US Patent 4,629,314).**

**Regarding claims 4, 8 and 12:** Hisatake discloses a document reading device (figure 2; figure 18; figure 19; and column 19, lines 42-50 of Hisatake) comprising a document table (figure 18(M4) of Hisatake) which supports a document placed thereon (column 19, lines 62-65 of Hisatake); a cover (shown in figure 18 of Hisatake) which covers the document on said document table, and is configured to be opened and closed with respect to said document table (column 20, lines 4-6 of Hisatake); a document feeder (figure 18(M2) of Hisatake) which feeds a document other than the document on said document table (column 20, lines 4-12 of Hisatake); a document reader (figure 18(M5) of Hisatake) which reads an image of the document placed on said document table or fed by said document feeder (column 20, lines

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13-26 of Hisatake); a user interface (figure 8; figure 19(53); and column 21, lines 50-53 of Hisatake) which designates a document size for the document to be output, which is magnified at 100% and is thus the same as the document read by said document reader (figure 8(Sheet); column 12, lines 61-64; and column 13, lines 1-7 of Hisatake), said user interface being operated manually (column 13, lines 1-3 of Hisatake – *operator manually making adjustments*); and a controller (figure 19(52) and column 21, lines 50-56 of Hisatake) which specifies a read size corresponding to the document size designated by said user interface (column 12, lines 61-64 and column 13, lines 1-7 of Hisatake) and which controls said document reader to read the image of the document in the read size (column 21, lines 50-56 of Hisatake); said controller being configured to hold the document size designated for a document placed on said document table while said cover is closed (figure 8 and column 12, lines 54-64 of Hisatake), and to refer to the maintained document size as the read size of the document placed on the document table even when the reading of the document on said document table is interrupted by reading an image of a document fed by said document feeder (column 12, lines 61-64 of Hisatake). The printing for the multiple pages of a print job is set beforehand, stored and used for the overall printing of the print job (column 12, lines 61-64 of Hisatake). Thus, the interruption that naturally occurs when a new document page is fed by the document feeder does not cause a change in the preset document size.

Hisatake does not disclose expressly that said user interface specifically designates a document size for the document to be *read by said document reader*; and that said controller refers to said maintained document size to reinstate the read size which is changed when the reading of the document on said document table is interrupted by reading an image of a document fed by said document feeder, so as to complete the reading of the document on the document table without requiring designation of the document size for the document on the document table to be made by said user interface again.

Markham discloses a controller (figure 4 and column 11, lines 40-47 of Markham) which refers to a maintained document size (column 13, lines 23-28 of Markham – *document size would be a part of the prior task data*) to reinstate a read size which is changed when the reading of the document on said document table is interrupted by reading an image of a document fed by the document feeder, so as to complete the reading of the document on the document table without requiring designation of the document size for the document on the document table to be made by the user interface again (column 13, lines 28-41 and lines 58-68 of Markham).

Hisatake and Markham are combinable because they are from the same field of endeavor, namely the control of document scanning and copying and the control of printing parameters. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to store print task data that is

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later recalled and used to complete the scanning and copying of a document on the document glass after an interruption by a different print task, as taught by Markham. The document size would inherently be a part of the prior task data since the document size is required for proper reading of the document. Further, even if *arguendo* it could be argued that the document size is not a part of the prior task data, the document size is one of the document print job characteristics specified in Hisatake. Thus, by combination, the prior task data taught by Markham would still contain the document size *as per* the teachings of Hisatake. The motivation for doing so would have been to be able to continue a suspended print job after finishing a more important or more urgent print task. Therefore, it would have been obvious to combine Markham with Hisatake.

Hisatake in view of Markham does not disclose expressly that said user interface specifically designates a document size for the document to be *read by said document reader*.

Yoshiura discloses a user interface which is used to manually designate a document size for the document to be read by a document reader (figure 2(6,13("MANUAL")) and column 4, lines 16-34 of Yoshiura).

Hisatake in view of Markham is combinable with Yoshiura because they are from the same field of endeavor, namely the control of document scanning and copying and the control of printing parameters. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include manual specification of the original document size at the user interface. The suggestion for doing so would have been that sometimes automatic document size detection is not successful, and therefore manual specification is needed (column 4, lines 16-22 of Yoshiura). Therefore, it would have been obvious to combine Yoshiura with Hisatake in view of Markham to obtain the invention as specified in claims 4, 8 and 12.

Further regarding claim 8: The various means recited in the device of claim 8 correspond to the respective portions of the device of claim 4.

Further regarding claim 12: The method of claim 12 is performed by the device of claim 4.

**Further regarding claims 5, 9 and 13:** Yoshiura discloses a document size detector which detects the size of the document on the document table (column 3, line 67 to column 4, line 4 of Yoshiura), wherein the controller is configured to request designation of the document size by the user interface when the document size detector fails to detect the size of the document on the document table (column 3, lines 64-66 and column 4, lines 16-28 of Yoshiura).

**Regarding claims 7, 11 and 15:** Hisatake discloses that said controller includes a memory which separately stores the document size designated for the document on said document table and the

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document size designated for the document fed by said document feeder (column 12, lines 54-67 of Hisatake). In order for the controller to be able to store, display and allow changes (via the user interface) of the print job, some form of memory is inherent.

**5. Claims 6, 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hisatake (US Patent 5,669,040) in view of Markham (US Patent 4,273,439), Yoshiura (US Patent 4,629,314), and Sogame (US Patent 4,673,282).**

**Regarding claims 6, 10 and 14:** Since the print jobs are performed for the normal operation of the system of Hisatake, it would be reasonable to assume that said controller is configured such that the document size designated for the document on said document table is cleared when said cover is opened. However, Hisatake in view of Markham and Yoshiura does not disclose expressly that said controller is configured such that the document size designated for the document on said document table is cleared when the cover is opened.

Sogame discloses that a controller is configured such that the document size designated for the document on said document table is cleared when said cover is opened (column 6, lines 5-13 of Sogame). The size detection only functions when the cover is closed (column 6, lines 5-13 of Sogame). Thus, the document size designated for the document on said document table is cleared when the cover is opened.

Hisatake in view of Markham and Yoshiura is combinable with Sogame because they are from the same field of endeavor, namely document size and document attribute detection and setting for digital copiers. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to clear the stored value for document size when the cover is opened, as taught by Sogame. The suggestion for doing so would have been that, with the cover open, outside light will interfere with the detection of the document size. Thus, document size detection will either be impossible or highly inaccurate. Therefore, it would have been obvious to combine Sogame with Hisatake in view of Markham and Yoshiura to obtain the invention as specified in claims 6, 10 and 14.

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***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

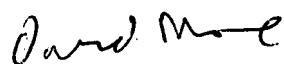
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Thompson whose telephone number is 571-272-7441. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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06 July 2007



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